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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,089	10/31/2003	Dirk Stenkamp	1/1407	1853
28501	7590	06/07/2007	EXAMINER	
MICHAEL P. MORRIS			POWERS, FIONA	
BOEHRINGER INGELHEIM CORPORATION			ART UNIT	PAPER NUMBER
900 RIDGEURY ROAD			1626	
P. O. BOX 368				
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MAIL DATE		DELIVERY MODE		
06/07/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/699,089	STENKAMP ET AL.
	Examiner Fiona T. Powers	Art Unit 1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5, 7-9, 12-18 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) 22-24 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5, 7-9 and 12-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

Art Unit: 1626

Receipt is acknowledged of the amendment filed March 29, 2007, which has been entered in the file.

Newly presented claims 22 to 24 are drawn to the same subject matter as claims 19 to 21 which were previously withdrawn. Accordingly, claims 22 to 24 stand withdrawn as being drawn to a non-elected invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 to 5, 7 to 9 and 12 to 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Proviso (M1) renders the claims indefinite because it excludes certain compounds in which X is an alkylenoxy group which is substituted by hydroxy but claim 1 has now been amended to exclude compounds where X is an alkylenoxy which is substituted by hydroxy. To clarify the claims this proviso should be deleted.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1626

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 to 5, 7 to 9, 12, 13, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guidicelli et al. (Chemical Abstracts, 50:2050d-e, 1956), cited.

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference discloses a structurally similar compound that is useful as an anesthetic. The compound of the reference is structurally similar to the claimed compounds wherein R¹ and R² are C₁₋₈-alkyl or R¹R²N is piperidine, R³ is H, X is C₂₋₃-alkylenoxy, Y is phenylene, Z is a direct bond, W is -CH₂CH₂-, A is phenyl and b is 0. Note the abstract and Registry No.

734500-14-2.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compound of the reference differs from the claimed compounds in that:

- a) the group that corresponds to X is CH₂CH₂O instead of CH₂CH₂CH₂O; or
- b) one of the groups that correspond to R¹ and R² is ethyl instead of methyl; or
- c) the group that corresponds to R¹R²N is diethylamino instead of piperidine.

Art Unit: 1626

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

The interchangeability of a) and c) above is taught by the reference. Note that in the abstract n can be 2 or 3 and B can be diethylamino or piperdinio. In addition, a) and b) above would make the compounds homologs and homologs are obvious over one another. One of ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that additional compounds useful as anesthetics would be obtained. The claimed compounds, salts and pharmaceutical compositions would have been rendered obvious by the structurally similar compound of the reference in the absence of any unobvious property.

Applicant's arguments filed March 29, 2007 have been fully considered and are persuasive. The rejections presented in the last office action have been withdrawn.

Claims 14 and 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is

Art Unit: 1626

reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fiona T. Powers
Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
June 6, 2007